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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,558	04/08/2004	Bennett Clay Byrd	41872-298797	8380
7590	07/24/2006		EXAMINER	
J. Michael Boggs Kilpatrick Stockton LLP 1001 West Fourth Street Winston-Salem, NC 27101-2400			PATTERSON, MARIE D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/820,558	BYRD ET AL.	
	Examiner	Art Unit	
	Marie Patterson	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 June 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9, 11, 12, 14-16, 18-24, 26-29 and 31 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 20-22 is/are allowed.
- 6) Claim(s) 1-9, 11, 12, 14-16, 18, 19, 23, 24, 26-29 and 31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 11, 12, 15, 16, 18, 19, 23, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serna (5983529) in view of either Hallenbeck (5125081) or Bacchiocchi (5086574).

Serna shows a shoe and inherent method of making a shoe comprising a midsole (10) with a cut-out (18), a display element (20), an outsole (30), and a transparent portion (38) substantially as claimed except for explicitly stating that the display element is removable. Serna does state that the elements "may be bonded together", and this phrase suggests also that the elements may not be bonded, i.e. the phrase does not state that the elements are required to be bonded. Either Hallenbeck or Bacchiocchi teaches that a display element (1 or 20) can be removable and replaceable (see column 6 lines 44-66 or column 4 lines 37-48). It would have been obvious to allow the display elements to be removable as taught by either Hallenbeck or Bacchiocchi in the shoe and method of Serna to allow different display elements to be used in accordance with the desired activity, decor, feel, fit, etc..

In reference to claims 4 and 5, the use of oval as a shape is considered to be an obvious choice of design and official notice is taken that the use of the shape of circular or oval for heel cushions is well known and conventional in the art of footwear. It would

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have been obvious to make the heel inserts/display elements circular or oval as is well known and conventional in the footwear of Serna as modified above to make the footwear easier, faster, and cheaper to manufacture.

In reference to claims 12 and 23, the display element inherently has a color.

3. Claims 1-9, 11, 12, 15, 16, 18, 19, 23, 24, 26-29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frachey (5369896) in view of either Hallenbeck (5125081) or Bacchiocchi (5086574).

Frachey shows a shoe and inherent method of making a shoe comprising a midsole (3) with a cut-out (16), a display element (13 and/or 13A), an insole (5) with a cut-out (14), an outsole (2), and a transparent portion (28) substantially as claimed except for explicitly stating that the display element is removable. Frachey does state that the securing element/projection 22 can be omitted (column 3 lines 38-39) and there is nothing in Frachey which states that the element 13 is not removable, i.e. there is not structure specifically recited that prevents the removal of element 13 or 13A. Either Hallenbeck or Bacchiocchi teaches that a display element (1 or 20) can be removable and replaceable (see column 6 lines 44-66 or column 4 lines 37-48). It would have been obvious to allow the display elements to be removable as taught by either Hallenbeck or Bacchiocchi in the shoe and method of Frachey to allow different display elements to be used in accordance with the desired activity, decor, feel, fit, etc..

In reference to claims 4 and 5, the use of oval as a shape is considered to be an obvious choice of design and official notice is taken that the use of the shape of circular or oval for heel cushions is well known and conventional in the art of footwear. It would

have been obvious to make the heel inserts/display elements circular or oval as is well known and conventional in the footwear of Frachey as modified above to make the footwear easier, faster, and cheaper to manufacture.

In reference to claims 12 and 23, the display element inherently has a color.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Serna or Frachey as modified above as applied to claim 1 above, and further in view of Weiss (2003/0084595).

Serna or Frachey as modified above shows a shoe substantially as claimed except for providing logo indicia on the insert/display element. Weiss teaches providing logo indicia (14) on the bottom viewable portion of an insert. It would have been obvious to provide logo indicia as taught by Weiss in the shoe of either Seran or Frachey as modified above to provide viewable indicia for amusement, sales, etc..

Allowable Subject Matter

5. Claims 20-22 are allowed.

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (572)272-8300 (**FORMAL FAXES ONLY**). Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson
Primary Examiner
Art Unit 3728